



Docket No.: 1293.1163

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jae-seong SHIM, et al.

Serial No. 09/756,694

Group Art Unit: 2631

Confirmation No. 4645

Filed: January 10, 2001

Examiner: Sudhanshu C. PATHAK

For: DATA REPRODUCING APPARATUS AND METHOD FOR IMPROVING DETECTION
PERFORMANCE BY ADJUSTING DECISION LEVELS USED IN DATA DETECTOR

COMMENTS REGARDING STATEMENT OF REASONS FOR ALLOWANCE

Mail Stop Issue Fee
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

On the Notice of Allowability (PTOL-37), mailed November 30, 2004, the Examiner checked box 8, indicating that the Notice of Allowability included an attachment of an "Examiner's Statement of Reasons for Allowance."

MPEP §1302.14 states, in part:

Where specific reasons are recorded by the examiner, care must be taken to ensure that statements of reasons for allowance (or indication of allowable subject matter) are accurate, precise and do not place unwarranted interpretations, whether broad or narrow upon the claims. The examiner should keep in mind the possible misinterpretations of his or her statement that may be made and its possible estoppel effects.

Although the Examiner checked the box 8, no comments are included in the Notice of Allowability which are clearly labeled "Statement of Reasons for Allowance" as indicated by MPEP 1302.14. To the extent that the Examiner may have intended a statement on page 2 of the Notice of Allowability, which begins "claims 1-23 are allowable over the prior art of record

because the cited references do not contain the specified limitation of a data reproducing apparatus comprising" and which ends with a recitation of Applicants claim 2, as a Statement of Reasons for Allowance, the following comments are provided.

Claim 1 recites one combination of features while other claims recite other combinations of features. Not all of the features of claim 1 are included in all the other claims.

By way of example, independent claim 10 makes no mention of a multiplexer or a plurality of averagers.

By way of another example, independent method claim 24 does not include any apparatus features which are recited in claim 2.

The foregoing is merely meant to be exemplary, and does not point out all of the discrepancies between the Examiner's Statement of Reasons for Allowance and the claimed features of the currently pending claims.

It is also noted that in an Office Action, mailed April 2, 2004, the Examiner includes comments at page 4, paragraph 7, regarding claims 21-23 and 24-25, now renumbered as claims 19-23. The comments in the Notice of Allowability regarding claims 21-23 and 24-25 are inconsistent with the comments regarding claims 21-23 and 24-25 in the Office Action of April 2, 2004.

It is further submitted that the claims speak for themselves and should not be interpreted based on the Examiner's characterizations of same. It is also submitted that the claims provide their own best evidence as to the reasons for allowance.

In summary, it is submitted that the Examiner's Statement "raises possible misinterpretations... and possible estoppel effects" (M.P.E.P. §1302.14) and is therefore improper.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 2/23/05

By: 

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